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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,251	07/08/1999	ARYE MALEK	139.059US1	7789

21186 7590 11/19/2003

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EXAMINER

NGUYEN, JOHN QUOC

ART UNIT	PAPER NUMBER
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3654

35

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/350,251

Applicant(s)

MALEK ET AL.

Examiner

John Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10, 12-25 and 27-42 is/are pending in the application.
- 4a) Of the above claim(s) 22-25, 31-36 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10, 12-21, 27-30, 37-40 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Applicant's election of the species of figs. 19A and 19B, claims 3-10, 12-21, 27-30, 37-40, and 42 in Papers No. 27 and 29 has been acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 22-25, 31-36, and 41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Papers No. 27 and 29.

Regarding claim 41, it should be noted that it was applicant who stated that claim 41 did not read on the elected species (Response of 2/3/03). It should be noted that claims 40-42 were added after the Restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12, 20, 21, 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how moving the tray in the claimed perpendicular direction reduces the travel distance as claimed (claims 12, 20, 21, 40).

All claims should be revised carefully to correct all other deficiencies similar to the ones noted above. The non-elected claims should also be similarly corrected at the same time so that the application can be allowed without delay should the generic claims become allowable.

Claims 3-9, 12-21, and 27-30, 40, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Jackson et al (US 6139243).

The admitted prior art discussed on pages 2-5 of the specification discloses substantially all the claimed features. Jackson et al discloses another similar apparatus in which the claimed inverting mechanism is disclosed. It would have been obvious to a person having ordinary skill in the art to provide the admitted prior art apparatus with an inverting mechanism as taught by Jackson et al to invert the devices. The picker and slider are old and well known in the art and the provision of such to the admitted prior art apparatus would have been obvious to a person having ordinary skill in the art to pick out undesirable devices and to transfer devices, respectively. It should be noted that the tray is deemed an intended use object in the machine-vision system and that statements of intended use carry little patentable weight; in other words, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. On the other hand, the type/size of the tray and the direction of movement (orientation) of the tray would have been an obvious matter of design choice to a person having ordinary skill in the art based on factors such as preference, design criteria (such as the size and shape of conveyor on which the trays sit), space optimization. Relative to claim 39, the number of inspection stations is

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deemed inherent in the admitted prior art or, alternatively, would have been an obvious matter of design choice to a person having ordinary skill in the art based on factors such as design criteria.

Claims 10 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Jackson et al as applied to claims 3-9, 12-21, and 27-30, 40, 42 above, and further in view of Bilodeau et al (US 5691810).

Bilodeau et al discloses another similar apparatus in which a pick and place mechanism 42 removes rejected devices and replaces them with good devices. It would have been obvious to a person having ordinary skill in the art to provide the admitted prior art modified as above with a pick and place mechanism as taught by Bilodeau et al to removed rejected devices and replaces them with good devices to obtain a all-good tray and reducing manual labor and manufacturing time and costs.

Applicant's arguments filed 9/26/03 have been fully considered but they are not persuasive.

As noted above, it is not clear how moving the tray in the claimed perpendicular direction reduces the travel distance as claimed. The distance between the two inspection stations cannot be shorter simply because the tray is shorter. If this were true, a person can therefore reduce the distance of travel between two cities by traveling in a shorter car. Since the inspection stations are fixed in location, the size or

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orientation of the tray has no effect on the distance that the tray needs to travel to go from the first station to the second station.

Furthermore, "perpendicular to the long-dimension side" is not necessarily the same as "in the short-dimension direction" since the tray may not be rectangular, may be square, and may have more than four sides where the short-dimension side is not perpendicular to the long-dimension side. This applies to claims 3, 12, 20, 21, and 40.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the stations can be placed closer to one another", "more trays can be placed in the path of travel", "there can be more trays along the path between machines, and thus the time per tray is reduced at a given tray speed", "if the stations are moved closer together", "since the stations could be placed closer to one another", "per-tray travel time between inspection", "affect the space needed", "shortening the distance of tray travel between stations", and "shortening the overall length of the machine in the direction of travel", "shrinks the footprint size of the conveyor needed", "reduces the jostleing and shaking of the devices in the tray due to fast start and stop motions if the trays were moved in the long dimension in the same amount of time") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

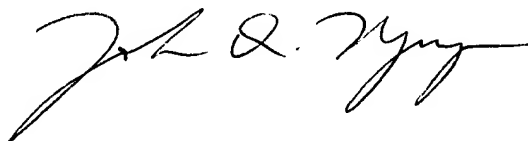
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Just because "more trays can be placed in the path of travel" does not necessarily result in reducing the travel distance. If this was true, then in a rush hour traffic, increasing the number of cars on a road should reduce the travel distance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Q. Nguyen whose telephone number is (703) 308-2689. The examiner can normally be reached on Monday-Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Matecki, can be reached on (703) 308-2688. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.

A handwritten signature in black ink, appearing to read "John Q. Nguyen". The signature is fluid and cursive, with the first name "John" and last name "Nguyen" clearly distinguishable.

John Q. Nguyen
Primary Examiner
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